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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,697	03/24/2004	Robert D. Bauer	8462/1/1	5603
7590 09/09/2004				
Wolff & Samson PC One Boland Drive West Orange, NJ 07052			EXAMINER ZHONG, CHAD	
			ART UNIT	PAPER NUMBER
			2152	

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<p style="text-align: center;"><b>Office Action Summary</b></p>	<p><b>Application No.</b></p> <p>10/807,697</p>	<p><b>Applicant(s)</b></p> <p>BAUER ET AL.</p>	
	<p><b>Examiner</b></p> <p>Chad Zhong</p>	<p><b>Art Unit</b></p> <p>2154</p>	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 29-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 29-33 are presented for examination.
2. It is noted that although the present application does contain line numbers in specification and claims, the line numbers in the claims do not correspond to the preferred format. The preferred format is to number each line of every claim, with each claim beginning with line 1. For ease of reference by both the Examiner and Applicant all future correspondence should include the recommended line numbering.
3. The disclosure is objected to because of the following informalities:  
pg 16, line 22, electronic communication service should be numbered 10 instead of 12.

### Claim Rejections - 35 USC § 112, second paragraph

4. Claims 29-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
  - a. The following terms lack antecedent basis:
    - i. the weighing – claim 32.
    - ii. the factors – claim 32.

### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donaldson, US

6,321,267 in view of Knowles et al. (hereinafter Knowles), US 5,905,863.

7. As per claim 29, Donaldson teaches a method of screening undesired electronic mail in an electronic communication service which comprises:

scanning an incoming mail message for an incoming sending source designation, an incoming domain designation (Col. 16, lines 1-5; Col. 4, lines 15-35);

generating a plurality of comparison index values from the incoming source designation, the incoming domain designation; and

identifying the incoming mail message as undesirable in response to a positive comparison between said plurality of comparison index values and known SPAM sources (Col. 14, lines 60-67; Col. 17, lines 50-64; Col. 21, lines 45-55; Col. 8, lines 35-45).

8. Donaldson does not explicitly teaches  
scanning an incoming text body

9. Knowles teaches  
scanning an incoming text body (Col. 7, lines 40-55; Col. 6, lines 45-50).

10. It would have been obvious to one of ordinary skill in this art at the time of invention was made to combine the teaching of Donaldson and Knowles because they both dealing with filtering of email messages. Furthermore, the teaching of Knowles to allow scanning an incoming text body would improve the identification aspect for Donaldson's system by further adding a constraint in an attempt to identify the email.

11. As per claim 30, Donaldson teaches the method of claim 29 wherein said identification is determined by the probability that the message is from an unwanted source, the frequency with which

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content appears in messages in the service, the number of hyperlinks, and the targets of the hyperlinks (Col. 15, lines 40-55; Col. 25, lines 1-15; Col. 26, lines 20-35; Col. 24, lines 1-12; Col. 4, lines 50-60).

9. As per claim 31, Donaldson teaches the method of claim 29 further comprising:

logging the incoming mail message in a SPAM database (Col. 27, lines 40-45);

updating a SPAM log database (Col. 27, lines 40-45); and

discarding the incoming message (Col. 29, lines 29-35).

10. As per claim 32, Donaldson teaches the method of claim 30 wherein the weighing of the factors can be varied by a system administrator (Col. 29, lines 29-35).

11. As per claim 33, Donaldson teaches the method of claim 29 further comprising:

scanning an incoming mail message for an incoming hypertext link;

generating a plurality of comparison index values from the incoming hyperlink; and

comparing the plurality of comparison index values to the SPAM database (Col. 29, lines 1-15; note that Donaldson is actively scanning the email message for hypertext links i.e. someone@smallhost.com and comparing it with a spam database to avoid future spamming).

### *Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents and publications are cited to further show the state of the art with respect to

“Electronic Communication Service”.

i. “Direct MarketingOnline To Avoid Spam, Check source of email lists”,  
Interactive PR & Marketing News, v5, n20, Oct 2, 1998.

ii. “competition law – dominant market position – anti-competitive behaviour –  
Competition Act 1998”, Collins, J Feb 11, 2000.

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iii. "UK CASE STUDY: The Postal Preference Service More of the mail you want, less of what you don't" 1999.

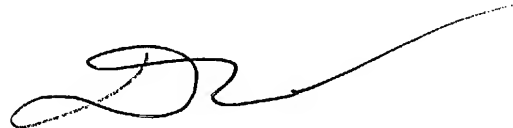
iv. "How a Retailing Stalwart Plans To Apply Precision of Direct Marketing to the Web. (Company Business and Marketing)" Andrews, Whit. Internet World June 14, 1999.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chad Zhong whose telephone number is (703) 305-0718. The examiner can normally be reached on M-F 7am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A Follansbee can be reached on 703-305-8498. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CZ  
August 9, 2004



Dung C. Dinh  
Primary Examiner